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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,976	04/12/2002	Egidio Renna	3-293 USA	5792
466	7590	12/16/2004	EXAMINER WEINSTEIN, STEVEN L	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			ART UNIT 1761	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,976

**Applicant(s)**

RENNA, EGIDIO

**Examiner**

Steven L. Weinstein

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 3-9, 11-15, 17 and 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                               |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/17/01</u> . | 6) <input type="checkbox"/> Other: _____                                                |

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Applicants response filed 8/11/04 to the election of species mailed 7/14/04 is acknowledged. Upon review of applicant's response, and in particular, the listing of claims thought to be readable on the elected embodiment, the examiner realized there was an apparent discrepancy between the species elected and the claims listed thereon. In order to clarify applicant's intent and to expedite prosecution, the examiner called Mr. Patch. Mr. Patch reviewed applicant's correspondence and confirmed that there was indeed an incorrect election and that the peg species should have been elected with the claims readable thereon being claims 1, 2, 10, 16 and 18-24. Accordingly, claims 3-9, 11-15, 17 and 25-28 have been withdrawn from further consideration as being drawn to non-elected species and an action on the merits of claim 1, 2, 10, 16 and 18-24 follows.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 10, 16 and 18-24 are rejected under 35 USC 112, second paragraph as being indefinite. The claims appear to use phrases or parts of phrases at various points in the claims, which phrases are not clearly linked thus making for confusion. It is suggested applicant review the claims carefully to review for problems such as antecedent basis. For example, line 5; claim 1 recites "housing means". However, line 7 of claim 1 recites "supporting and housing means". Is the latter "housing means" the same "housing means" recited in claim 1? Claim 1 also recites a dissolvable food product or a praline. Is not a praline a dissolvable food product? After reciting the dissolvable food product or a praline in lines 5 to 6, the remainder of the claim only

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refers to the praline and is silent as to the more generic dissolvable food product.

Further, the phrase an "optional" praline already housed in said plug, is unclear. That is, it is not clear if the praline is positively recited or not. It appears it is not. Yet further in the claim, the language, relative to the praline and beverage, appears to be positive, not functional (i.e. the last five lines of claim 1). Further, how does the opening in the housing means in claim 1 relate to the port of claim 2? Clarification and/or correction are requested. Note that all phrases in the claims beginning with "optional" or "preferably" are being construed as not being positive recitations that need be addressed. Similarly, all phrases that are linked by the word "or" can be read as one phrase or the other phrase. Both alternatives need not be addressed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 21<sup>-24</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over Chambers (2,975,925) in view of Coleman (5,324,527) and Harvey et al (3,730,737), further in view of Tarwinski (GB 2,259,241), Hamlin (5,312,014), Paulin (5,085,330) and Hasegawa (JP 55-150856).

In regard to claim 1, Chambers discloses a plug (10) for sucking a beverage, a coupling means (14) for coupling the plug to a vessel holding a beverage to be drunk, housing means (11,12) for housing a dissolvable food product, and supporting means (#23) for supporting the food product, wherein the body of the plug comprises a bottom,

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including a coupling means, a middle and a top portion; the housing means comprise chamber or seat and having at least an opening for allowing the beverage to exit therefrom; and the supporting means comprise holding elements (23) as a single piece, and wherein the food projects from the seat (23). Claim 1 also recites that the top portion of the plug is so contoured to provide an ergonomics bearing of the lips on the plug as a "teat". Chambers discloses the top portion is contoured to be placed in the mouth in contact with the lips. It is not clear what constitutes "an ergonomics bearing of the lips" and "as a teat". In any case, since Chambers allows one to place the top of the plug in ones mouth, the particular shape of this portion is seen to have been an obvious matter of design (e.g. a more curved top portion). Finally, the only other positive recitation of claim 1 is the removable outer covering means. Chambers discloses that the upper portion of the plug is also a removable outer covering means. However, as evidenced by Coleman and Harvey, it was well established to provide dissolvable food containing plugs with removable outer covering means. To modify Chamber and employ an outer covering means would have been an obvious function of whether one wanted to provide the dissolvable food product in an exposed position or not. Note, too, the art taken as a whole teaches structural arrangements wherein the beverage to be associated with the dissolvable food product is either delivered around or through the food product. Tarwinski, Hamlin and Paulin are relied on as further evidence of dissolvable food containing plugs for association with beverage containing vessels. Note that Paulin discloses that the coupling means can be screw threads, which, of course, would have been an obvious function of the type of vessel that is to be coupled

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to the plug. Hasegawa can be relied on as further evidence of the conventionality of simultaneously tasting a dissolvable food product and a drink. In regard to claim 2, Chambers, Harvey et al, Tarwinski, Hamlin and Paulin all teach the conventionality of ports to communicate with the inside of the vessel. In regard to claim 21, and as noted above, the art taken as a whole teaches the conventionality of fixedly coupling a plug to a vessel. In regard to claim 22, whether the food projects above the top of the plug is seen to have been an obvious matter of choice and/or design in view of the art taken as a whole teaching enclosed food or exposed food associated with plugs/closures. In regard to claim 23, the slot size is seen to have been obvious function of the desired flow rate (i.e. an obvious result effective variable). In regard to claim 24, to package the plug independently of a beverage vessel would have been obvious in view of Tarwinski who teaches a self contained, separate plug.

Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Gallart et al (6,221,407).

Claim 10 recites a peg element and radial arms. Chambers discloses radial arms extending from the plug but omits the peg element. As evidenced by Gallart et al, it was conventional in the art to support a dissolvable food product on a peg element (e.g. 28). To modify the combination and provide Chambers with a peg for support for its art recognized and applicant's intended function is therefore seen to have been obvious. In regard to claim 16, whether one chooses to make any structure, including the peg, integral with its surrounding structure(s) or removably coupled is seen to have

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been an obvious matter of choice and/or design. Similarly, in regard to the "puppet" configuration, to form any formable material into any recognizable shape is seen to have been an obvious matter of design.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Mazer et al (5,921,955), Luzenberg (6,541,055), Nohren (6,221,416), Beck et al (5,328,063) and Crisci (5,104,008) and Adams (6,095,375).

Claim 18 recites that the plug is made with a push- pull or telescopic pattern. As evidenced by Mazer et al, Luzenberg, Nohren, Beck et al, Crisci and Adams, the art is replete with examples of push pull or telescopic configurations for plugs for beverage bottles and to modify the art and substitute one conventional plug or closure configuration for another conventional plug or closure configuration for its art recognized and applicants intended for function is seen to have been obvious. Note that the art teaches the closure can include dissolvable products. In regard to claims 19 and 20, the art taken as a whole which is relied on to show the push/pull or telescopic configuration, teach that the delivery ports are closed in the closed position.

The remainder of the references cited on the USPTO 892 forms are cited as art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Weinstein whose telephone number is (571) 272-1410. The examiner can normally be reached on Monday thru Friday from 7:00 AM to 3:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Weinstein/LR/dh  
November 24, 2004

Corrected  
December 1, 2004

*Steven Weinstein*

STEVE WEINSTEIN  
PRIMARY EXAMINER

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